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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,905	01/29/2002	Stephen Ritland	4510-4	9462

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EXAMINER

O CONNOR, CARY E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/060,905

Applicant(s)

RITLAND

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 10-12, 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 9, 13, 15, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Co et al (5,913,818). Co shows a retractor comprising a guide portion 15 having a guide channel 18, a handle 14 connected angularly with respect to a first end of the guide portion, and an insert 60 configured to fit within the channel, wherein the insert has an aperture extending lengthwise therethrough. The diameter of the aperture cannot be given patentable weight in the claim because it is based on a tool that is not positively claimed. As to claim 7, note the means for stabilizing the insert 40. As to claim 8, note the projection 16 at the distal end of the guide channel. As to the language that the retractor is for placement of a pedicle screw, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See

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*In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 1-3, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Coles (4,232,610). Coles shows a retractor comprising a guide portion 24 having a guide channel 28, a handle 14 connected angularly with respect to a first end of the guide portion, and an insert 32 configured to fit within the channel, wherein the insert has an aperture extending lengthwise therethrough. The diameter of the aperture cannot be given patentable weight in the claim because it is based on a tool that is not positively claimed. As to claims 2, 3 and 11, not the means for stabilizing 16 includes a projection extending from the guide portion. As to the language that the retractor is for placement of a pedicle screw, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coles (4,232,610) in view of Melkent et al (6,348,058). The device of Coles does not include an image tracker. Melkent shows a retractor 130 having an image tracker 190 mounted thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Coles with an image tracker mounted thereon, in view of Melkent, so that the location of the device within the body can be easily determined.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Co et al (5,913,818) in view of Melkent et al (6,348,058). The device of Co does not include an image tracker. Melkent shows a retractor 130 having an image tracker 190 mounted thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Co with an image tracker mounted thereon, in view of Melkent, so that the location of the device within the body can be easily determined.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melkent et al (6,348,058). Melkent shows a retractor 130 having a guide portion 132 and a guide channel extending longitudinally therealong, a handle 310 connected to the guide portion, and an image tracker 190. However, the image tracker is attached to the guide portion and not the handle. Melkent shows other instruments in Figures 9-11B where the image tracker is attached to the handle. It would have been obvious to

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one of ordinary skill in the art to one at the time the invention was made to mount the image tracker on the handle rather than the guide portion itself so that the guide portion may be inserted further into the body cavity. As to claim 17, note the reamer 300.

***Allowable Subject Matter***

Claims 4, 5, 9, 13, 15, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 is allowed.

***Claim Objections***

Claims 4 and 9 are objected to because of the following informalities: In line 3 of claims 4 and 9 "service" should be changed to --surface--. Appropriate correction is required.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Cary E. O'Connor  
Primary Examiner  
Art Unit 3732

ceo  
September 29, 2003